

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HORST GRAVEMANN and THOMAS HELMENKAMP

Appeal No. 1996-2484
Application 08/239,439¹

HEARD: January 12, 2000

Before OWENS, WALTZ and LIEBERMAN, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 21-34 as amended after final rejection. These are all

¹ Application for patent filed May 6, 1994. According to appellants, the application is a continuation of Application 07/994,385, filed December 21, 1992, now abandoned.

of the claims remaining in the application.²

THE INVENTION

Appellants claim an article of manufacture which includes a casting roll or casting wheel comprised of a recited alloy. Claims 21 and 28 are illustrative and read as follows:

21. An article of manufacture comprising:

a casting roll or casting wheel comprised of a hardenable copper alloy comprising

1.0 to 2.6% nickel,

0.1 to 0.45% beryllium

and the remainder of copper,

wherein said alloy has a Brinell hardness of at least 200 and an electric conductivity of over 38 m/S/mm².

28. An article of manufacture comprising:

a casting roll or casting wheel comprised of a hardenable copper alloy comprising

1.0 to 2.6% cobalt,

² The advisory action mailed on September 11, 1995 (paper no. 21) states that upon the filing of an appeal, the amendment filed on August 24, 1995 (paper no. 20) will be entered. Our consideration of the appeal is based on the claims as set forth in this amendment. The amendment, however, has not been clerically entered and, therefore, needs to be entered after the file is returned to the examining group.

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0.1 to 0.45% beryllium

and the remainder of copper,

wherein said alloy has a Brinell hardness of at least 200 and
an an electric conductivity of over 38 m/S/mm².

THE REFERENCES

Lane et al. (Lane) 1965	3,196,006	Jul. 20,
Wikle 1979	4,179,314	Dec. 18,
Guha 1987	4,657,601	Apr. 14,
Matsui et al. (Matsui) 1988	4,792,365	Dec. 20,
Hiramitsu et al. (Hiramitsu) 1991	5,074,922	Dec. 24,

Abstract no. 89-230977 [32] WPIDS, abstract of JP 1-165736,
June 29, 1989 (JP '736).

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as
follows: claims 21-34 over Matsui, Guha or Wikle, in view of
Lane or JP '736; claims 21, 24, 26, 28, 29, 31 and 33 over
Hiramitsu; and claims 22, 23, 25, 27, 30, 32 and 34 over
Hiramitsu in view of Matsui.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

Each of appellants' independent claims recites an article of manufacture which comprises a casting roll or casting wheel comprised of a specified alloy. The examiner argues that because the structure of the casting wheel or roll is not recited, appellants are claiming the alloy itself (answer, pages 5-7). This argument is not well taken because "casting roll or casting wheel" is a recitation of structure, i.e., a roll or wheel which is suitable for casting. As indicated by appellants' specification (page 1, lines 11-15), casting involves contact of the casting wheel or roll with a molten metal or alloy. Thus, the material of which a casting wheel or roll is made must be capable of withstanding contact with such a molten material.

The examiner, however, has provided no evidence or

reasoning which shows that the alloys which the applied references disclose or would have fairly suggested, to one of ordinary skill in the art, would have been considered by one of ordinary skill in the art to be suitable as a material of construction of a casting roll or casting wheel. In the applied references, the alloys are used in devices such as welding electrodes, electrical switches, relays and connectors, springs, contacts, and injection molding tools. The examiner has not explained why the applied references would have provided one of ordinary skill in the art with a reasonable expectation that the alloys recited in appellants' claims are suitable as a material of construction of a casting wheel or casting roll. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988); *In re Longi*, 759 F.2d 887, 892-93, 225 USPQ 645, 648 (Fed. Cir. 1985). The examiner, therefore, has not carried the burden of establishing a *prima facie* case of obviousness. Consequently, we do not sustain the examiner's rejections.

DECISION

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The rejections under 35 U.S.C. § 103 of claims 21-34 over Matsui, Guha or Wikle, in view of Lane or JP '736, claims 21, 24, 26, 28, 29, 31 and 33 over Hiramitsu, and claims 22, 23, 25, 27, 30, 32 and 34 over Hiramitsu in view of Matsui, are reversed.

REVERSED

TERRY J. OWENS)
Administrative Patent Judge)
)
) BOARD OF PATENT
THOMAS A. WALTZ)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
PAUL LIEBERMAN)
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